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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,145	03/02/2004	Mitzi R. Hail	08324.0005-00000	3036
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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413				
EXAMINER				
LE, LINH GIANG				
ART UNIT		PAPER NUMBER		
3686				
MAIL DATE		DELIVERY MODE		
04/27/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/790,145

**Applicant(s)**

HAIL ET AL.

**Examiner**

MICHELLE LE

**Art Unit**

3686

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/6/09 has been entered. Claims 1-12, 16, 21, 24, 26-30, and 33 have been amended. Claims 1-36 remain pending.

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Applicant has incorporated a machine or transformation to the method claims consistent with the guidelines for statutory subject matter under 35 USC 101 thus the rejection of the process claims under 35 USC 101 is hereby withdrawn.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. It is not clear *what* is doing the “determining” step in claim 1. Method claims should include active positive steps tied to a machine or transformation.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kucera (4,773,009) in view of Rojewski (7,343,308) for substantially the same reasons as stated in the 4/3/08 Office Action:

8. As per claim 1, Kucera and Rojewski collectively teach a method for processing insurance claims comprising:

analyzing text by a text analyzer, the text comprising at least one of the following:  
sentence textual groups and non-sentence textual groups (Kucera; (Col. 3, line 65 to Col. 4, line 15);

Kucera does not expressly teach the text is associated with an insurance claim to extract data elements related to the insurance claim's subrogation potential, and determining if the insurance claim has subrogation potential based on the scores assigned to each of the data elements. However this is well known in the art as evidenced by Rojewski. In particular, Rojewski teaches a system and method to automatically score a claim and determine the likelihood of subrogation potential (Rojewski; Col. 2, lines 33-50). Thus the process of scoring an insurance claim to determine subrogation potential was old and well known in the art. Since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

9. Kucera also does not expressly teach developing a subrogation potential score by a rules engine for each of the data elements wherein the developing further comprises: calculating the subrogation potential score using a set of rules created from

existing historical claim data, or assigning the subrogation potential score using the set of rules. However, this is well known in the art as evidenced by Rojewski. Rojewski teaches valuing a subrogation opportunity by reviewing criteria such as accident description, loss state, responsible party etc... (Rojewski, Col. 2, lines 33-50).

Examiner submits this reads upon assigning a subrogation potential score using a set of rules. Further Rojewski teaches factor values are derived from an assessment of similar historical claims recoveries (Rojewski; Col. 2, lines 60-65) which reads upon calculating a subrogation potential score using a set of rules created from exiting historical claim data. Since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

10. As per claim 2, Kucera does not expressly teach storing the extracted data elements in data tables corresponding to the insurance claim. However, this is well known in the art as evidenced by Rojewski. In particular, Rojewski teaches claim files stored in the data warehouse (Rojewski; Col. 3, lines 3-20). Since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

11. As per claim 3, Kucera teaches wherein the analyzing further comprises: separating the text into words (Kucera; Col. 9, line 43 to Col. 10, line 8); collecting the words into groups (Kucera; Col. 9, line 43 to Col. 10, line 8); and parsing the groups into the data elements (Kucera; Col. 9, line 43 to Col. 10, line 8).

12. As per claim 4, Kucera teaches wherein the groups are non-sentence groupings (Kucera; Col. 9, line 43 to Col. 10, line 8). Examiner submits that the analysis of individual words for inflection analysis reads on "non-sentence groupings."

13. As per claim 5, Kucera teaches wherein the non-sentence groupings are compared to a dictionary before being entered into the data table (Kucera; Col. 4, lines 1-15).

14. As per claim 6, Kucera teaches wherein the groups are sentences (Kucera; Col. 4, lines 48-56).

15. Claims 7-11, 12-15, 16-20, 21-23, 24-29, 30-32, 33-26 repeat substantially the same limitations as claims 1-6 and are taught by Kucera and Rojewski collectively. The reasons for rejection are incorporated herein.

***Response to Arguments***

16. Applicant's arguments filed 2/6/09 have been fully considered but they are not persuasive. Applicant argues that the rejection of the claims under 35 USC 103 is improper. Examiner disagrees.

17. Applicant argues that Kucera in view of Rojewski does not teach analyzing text associated with an insurance claim by a text analyzer to extract data elements of the insurance claim related to the insurance claims subrogation potential, the text comprising at least one of the following: sentence textual groups and non-sentence textual groups. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Kucera teaches a text analyzer that analyzes text comprising at least sentence textual groups and non-sentence textual groups. Thus, the claims as written do not require the prior art teach both sentence and non-sentence textual groups. However assuming arguendo the claims did require teaching of analysis of both types of groups, Kucera does teach analysis of non-sentence textual groups. In Kucera a list of words containing the same base word is compiled to check for inflection frequency (Kucera; Col. 9, line 43-68). Examiner submits that the list of words including "work," worked," "working" etc... reads on "non-sentence textual groups."



18. Applicant further argues there is insufficient motivation to combine the applied references. As discussed in the *KSR International Co. v. Teleflex Inc. et al.*, 127 S.Ct 1727 (2007), "[o]ften, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit. See *In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006) ('[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness'). As our precedents make clear, however, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ" (emphasis added). In this case, it would have been obvious to add the teachings of Rojewski to calculate subrogation potential with Kucera with the motivation of identifying subrogation potential and subrogation file valuing (Rojewski; Col. 1, lines 13-16). Furthermore the subrogation scoring of Rojewski in combination with Kucera would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized the results of the combination were predictable.

***Conclusion***

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHELLE LE whose telephone number is (571) 272-8207. The examiner can normally be reached on 8 AM - 5PM, M-F.

21. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry O'Connor can be reached on (571) 272-6787. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or (571) 272-1000.

4/21/09

/M. L./

Examiner, Art Unit 3686

/Gerald J. O'Connor/  
Supervisory Patent Examiner  
Group Art Unit 3686